

REMARKS/ARGUMENTS

Applicants acknowledge with appreciation the courtesies extended by the Examiner in the telephone interview on September 15, 2004. During the interview, all outstanding rejections were discussed, as explained in detail below.

Claims 1-4 are pending in the present application. In the present Office Action, the Examiner has maintained the rejection of claim 1 for allegedly being unpatentable for obviousness-type double patenting over claim 1 of USSN 10/033,426. Claims 2-4 stand rejected for obviousness-type double patenting over claim 1 of the '426 application in view of Gazeau (US Publication No. 2003/0059341). In addition, the claims remain rejected for allegedly being obvious over Nakao (US Patent 6,589,740) in view of Gazeau.

Obviousness-type Double Patenting

In the current Office Action, the Examiner acknowledges that the claims of the cited '426 application are directed to agitation of the solution by swinging of a rigid segment, whereas the present claims are directed to agitation by oscillating the entire cartridge. Nonetheless, the Examiner maintains that these two methods are "obvious variations" of each other.

As discussed during the interview, although applicants believe the rejection is improper, a terminal disclaimer is submitted herewith in order to expedite prosecution.

Rejection under 35 U.S.C. § 103(a)

The rejection of claims 1-4 for allegedly being obvious over Nakao and Gazeau is respectfully traversed. According to the Examiner, Nakao discloses a method of contacting a sample solution with a nucleic acid array and Gazeau allegedly teaches a succession of stops and starts on centrifuge rotor to mix the sample solution.

It is well settled that to maintain a rejection for obviousness, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. In addition, to support the rejection, the examiner must "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the

teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) and MPEP § 2142.

As explained during the interview, the present claims are not generally directed to oscillating but require a specific type of oscillating. In particular, Claim 1 of the present application is directed to methods which use a chip shaped carrier held in a cartridge and a cartridge holder. The claim requires a step of

oscillating said cartridge holder and thereby said cartridge about an axis of rotation ***which is substantially perpendicular to a vertical plane*** and thereby moving said cartridge back and forth between a first angular position and a second angular position which lie on opposite sides of ***an intermediate angular position at which said active surface of said chip shaped carrier is substantially at a lowest part of its motion path caused by said oscillating of said cartridge***, in order to cause relative motion of the liquid contained in said channel with respect to said active surface of said chip shaped carrier. (emphasis added)

Thus, the methods of the present claims require that the entire cartridge rotate about an axis that is ***substantially perpendicular to a vertical plane*** and that the cartridge pass through an intermediate position that is the ***lowest part of its motion path***. To maintain the rejection, the Examiner must show where ***all*** these limitations are taught or suggested in the cited art.

Applicants respectfully submit that the neither cited reference discloses or suggests oscillating a cartridge about an axis that is substantially perpendicular to a vertical plane and where the cartridge passes through an intermediate position that is the lowest part of its motion path. In the absence of such a showing the rejection is improper and should be withdrawn.

CONCLUSION


In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested. If

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PATENT

the a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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